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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/652,899 | 08/31/2000 | Fred Alan Bishop | 10655.8000 | 3558 |

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06/25/2004

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| EXAMINER |
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WORJLOH, JALATEE

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| ART UNIT | PAPER NUMBER |
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3621

DATE MAILED: 06/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/652,899

Applicant(s)

BISHOP ET AL.

Examiner

Jalatee Worjloh

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,43-46 and 90-103 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,43-46 and 90-103 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 3621

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 14, 2004 has been entered.
2. Claims 1-4,43-46 and 90-103 have been examined.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4,43-46 and 90 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6327578 to Linehan in view of US Patent No. 5590197 to Chen et al.

Linehan discloses receiving a transaction request from a user at a server, issuing a challenge to the user, receiving a response from the user based upon said challenge and processing said response to verify an instrument (see col. 7, lines 20-38). Linehan does not expressly disclose assembling credentials for the transaction at said server, said credentials comprising at least one key, providing at least a portion of said assembled credentials to said user, receiving a second request from said user at said server, said second request including said portion of said assembled credentials provided to said user and validating at said server, said

Art Unit: 3621

portion of said assembled credentials provided to said user with said key of said assembled credentials to provide access to a transaction service. Chen et al. disclose assembling credentials for the transaction at said server, said credentials comprising at least one key, providing at least a portion of said assembled credentials to said user, receiving a second request from said user at said server, said second request including said portion of said assembled credentials provided to said user and validating at said server, said portion of said assembled credentials provided to said user with said key of said assembled credentials to provide access to a transaction service (see col. 6, lines 12-57). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Linehan to include the steps of assembling credentials for the transaction at said server, said credentials comprising at least one key, providing at least a portion of said assembled credentials to said user, receiving a second request from said user at said server, said second request including said portion of said assembled credentials provided to said user and validating at said server, said portion of said assembled credentials provided to said user with said key of said assembled credentials to provide access to a transaction service. One of ordinary skill in the art would have been motivated to do this because it provides additional security by preventing unauthorized individuals from accessing the service.

Referring to claims 2, 3, 44 and 45, Linehan discloses the transaction is an electronic purchase transaction conducted using a digital wallet (see abstract, lines 1-4).

Referring to claim 4, Linehan discloses the instrument is a smartcard (see col. 7, lines 21-23).

Art Unit: 3621

Referring to claim 43, Linehan discloses receiving a transaction request from a user at a server, issuing a challenge to the user, receiving a response from the user based upon said challenge and processing said response to verify the user (see col. 7, lines 20-38). Linehan does not expressly disclose assembling credentials for the transaction at said server, said credentials comprising at least one key, providing at least a portion of said assembled credentials to said user, receiving a second request from said user at said server, said second request including said portion of said assembled credentials provided to said user and validating at said server, said portion of said assembled credentials provided to said user with said key of said assembled credentials to provide access to a transaction service. Chen et al. disclose assembling credentials for the transaction at said server, said credentials comprising at least one key, providing at least a portion of said assembled credentials to said user, receiving a second request from said user at said server, said second request including said portion of said assembled credentials provided to said user and validating at said server, said portion of said assembled credentials provided to said user with said key of said assembled credentials to provide access to a transaction service (see col. 6, lines 12-57). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Linehan to include the steps of assembling credentials for the transaction at said server, said credentials comprising at least one key, providing at least a portion of said assembled credentials to said user, receiving a second request from said user at said server, said second request including said portion of said assembled credentials provided to said user and validating at said server, said portion of said assembled credentials provided to said user with said key of said assembled credentials to provide access to a transaction service. One of ordinary skill in the art would have been

Art Unit: 3621

motivated to do this because it provides additional security by preventing unauthorized individuals from accessing the service.

Referring to claim 46, Linehan discloses the method wherein the user conducts the transaction via a smartcard (see col. 7, lines 21-23).

Referring to claim 90, Linehan discloses receiving a transaction request from a user at a server, issuing a challenge to the user, receiving a response from the user based upon said challenge and processing said response to verify an instrument (see col. 7, lines 20-38). Linehan does not expressly disclose assembling credentials for the transaction at said server, said credentials comprising at least one key, providing at least a portion of said assembled credentials to said user, receiving a second request from said user at said server indicating readiness to complete the transaction, said second request including said portion of said assembled credentials provided to said user and validating, at said server, said portion of said assembled credentials provided to said user of said assembled credentials to thereby permit processing and completion of said transaction. Chen et al. disclose assembling credentials for the transaction at said server, said credentials comprising at least one key, providing at least a portion of said assembled credentials to said user, receiving a second request from said user at said server indicating readiness to complete the transaction, said second request including said portion of said assembled credentials provided to said user and validating, at said server, said portion of said assembled credentials provided to said user of said assembled credentials to thereby permit processing and completion of said transaction (see col. 6, lines 12-57). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Linehan to include the steps of assembling credentials for the transaction at

Art Unit: 3621

said server, said credentials comprising at least one key, providing at least a portion of said assembled credentials to said user, receiving a second request from said user at said server indicating readiness to complete the transaction, said second request including said portion of said assembled credentials provided to said user and validating, at said server, said portion of said assembled credentials provided to said user of said assembled credentials to thereby permit processing and completion of said transaction. One of ordinary skill in the art would have been motivated to do this because it provides additional security by preventing unauthorized individuals from accessing the service.

5. Claims 91-97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linehan and Chen et al. as applied to claim 90 above, and further in view of US Publication No. 2004/0031856 to Atsmon et al.

Linehan discloses accessing required information associated with said user form said server (see col. 4, lines 28-31) and said server providing an authorization response message to a merchant for processing and completion of said transaction (see col. 4, lines 37-40). Linehan does not expressly disclose populating one or more corresponding user purchase forms at said server with said required information and said server providing said populated user purchase forms to a merchant. Atsmon et al. disclose accessing required information associated with said user form said server, populating one or more corresponding user purchase forms at said server with said required information and said server providing said populated user purchase forms to a merchant for processing and completion of said transaction (see paragraph [0584]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to

Art Unit: 3621

modified to the method disclose by Linehan to include the steps of disclose populating one or more corresponding user purchase forms at said server with said required information and said server providing said populated user purchase forms to a merchant. One of ordinary skill in the art would have been motivated to do this because it provides an electronic system that allows users to easily interact with a merchant (see Atsmon paragraph [0014]).

Referring to claims 92 and 94, Linehan discloses said transaction is an electronic purchase transaction conducting using a digital wallet (see abstract, lines 1-4).

Referring to claim 93, Linehan discloses said transaction is a web-based purchase transaction (see col. 7, lines 55-59).

Referring to claim 95, Linehan discloses said web-based purchase transaction is conducted using a digital wallet (see abstract, lines 1-4; col. 7, lines 55-59).

Referring to claim 96, Linehan discloses the instrument is a smartcard (see col. 7, lines 21-23).

Referring to claim 97, Linehan discloses the method for conducting a transaction. Linehan does not expressly disclose required information includes user name, user address, shipping address, and card number and payment amount. Atsmon et al. disclose required information includes user name, user address, shipping address, card number and payment amount (see paragraph [0584]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Linehan to include required information includes user name, user address, shipping address, card number and payment amount. One of ordinary skill in the art would have been motivated to do this because

Art Unit: 3621

it provides an electronic system, which retrieves conventional purchase information, allowing users to easily interact with a merchant (see Atsmon paragraph [0014]).

6. Claims 98-103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linehan and Chen et al. in view of Atsmon et al.

Linehan discloses receiving a transaction request from a user at a server, issuing a challenge to the user, receiving a response from the user based upon said challenge, processing said response to verify an instrument (see col. 7, lines 20-38), accessing required information associated with said user from said server (see col. 4, lines 28-31) and said server providing an authorization response message to a merchant for processing and completion of said transaction (see col. 4, lines 37-40). Linehan does not expressly disclose providing at least a portion of said assembled credentials to said user, receiving a second request from said user at said server indicating readiness to complete the transaction, said second request including said portion of said assembled credentials provided to said user and validating, at said server, said portion of said assembled credentials provided to said user of said assembled credentials to thereby permit processing and completion of said transaction and populating one or more corresponding user purchase forms at said server with said required information and said server providing said populated user purchase forms to a merchant. Chen et al. disclose assembling credentials for the transaction at said server, said credentials comprising at least one key, providing at least a portion of said assembled credentials to said user, receiving a second request from said user at said server indicating readiness to complete the transaction, said second request including said portion of said assembled credentials provided to said user and validating, at said server, said portion of said assembled credentials provided to said user of said assembled credentials to

Art Unit: 3621

thereby permit processing and completion of said transaction (see col. 6, lines 12-57). Atsmon et al. disclose accessing required formation associated with said user form said server, populating one or more corresponding user purchase forms at said server with said required information and said server providing said populated user purchase forms to a merchant for processing and completion of said transaction (see paragraph [0584]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modified to the method disclose by Linehan to include the steps of disclose populating one or more corresponding user purchase forms at said server with said required information and said server providing said populated user purchase forms to a merchant. One of ordinary skill in the art would have been motivated to do this because it provides an electronic system that allows users to easily interact with a merchant (see Atsmon paragraph [0014]).

Referring to claim 99, Linehan discloses receiving said challenge at said instrument (see col. 7, lines 25-30). Linehan does not expressly disclose said instrument prompting said user form a personal identifier, receiving said personal identifier from said user, said instrument validating said personal identifier and unlocking said instrument, and said instrument transmitting said response to said server. Chen et al. disclose said instrument prompting said user form a personal identifier, receiving said personal identifier from said user, said instrument validating said personal identifier and unlocking said instrument, and said instrument transmitting said response to said server (see col. 6, liens 38-45). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Linehan to include the step where said instrument prompting said user form a personal identifier, receiving said personal identifier from said user, said instrument validating

Art Unit: 3621

said personal identifier and unlocking said instrument, and said instrument transmitting said response to said server. One of ordinary skill in the art would have been motivated to do this because provides security by preventing unauthorized individuals from accessing the instrument.

Referring to claim 100, Linehan discloses the electronic purchase transaction is conducted using a digital wallet (see abstract, lines 1-4).

Referring to claim 101, Linehan discloses the instrument is a smartcard (see col. 7, lines 21-23).

Referring to claim 102, Linehan discloses said electronic purchase transaction is a web-based transaction (see col. 7, lines 55-59).

Referring to claim 103, Linehan discloses the method for conducting a transaction. Linehan does not expressly disclose required information includes user name, user address, shipping address, and card number and payment amount. Atsmon et al. disclose required information includes user name, user address, shipping address, card number and payment amount (see paragraph [0584]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Linehan to include required information includes user name, user address, shipping address, card number and payment amount. One of ordinary skill in the art would have been motivated to do this because it provides an electronic system, which retrieves conventional purchase information, allowing users to easily interact with a merchant (see Atsmon paragraph [0014]).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306, 703-746-9443 for Non-Official/Draft.

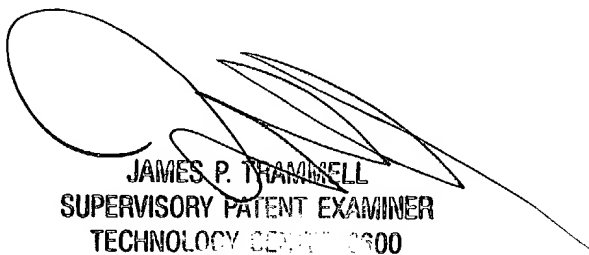
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Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
PO Box 1450
Alexandria, VA 22313-1450

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, V.A., Seventh floor receptionist.

June 17, 2004


JAMES P. TRAMMELL
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